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HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202				
EXAMINER WORJLOH, JALATEE				
ART UNIT		PAPER NUMBER		
3621				

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/427,968

Applicant(s)

COOK, DAVID P.

Examiner

Jalatee Worjloh

Art Unit

3621

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-9, 13-15 and 19-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9 and 11-15 is/are allowed.
- 6) ☒ Claim(s) 19-43 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is responsive to the amendment filed on March 17, 2004, in which claims 22 and 28 were amended and claims 37-44 added.

#### ***Response to Arguments***

2. Applicant's arguments, see pages 8 and 9, filed March 17, 2004 with respect to Claim 13 have been fully considered and are persuasive. The rejection of claim 13 has been withdrawn.
3. Applicant's arguments with respect to claims 22 and 28 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 43 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 43 recites the limitation "the user" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3621

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 19-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talati et al. in further view of US Patent No. 6327578 to Linehan.

Referring to claim 22, Talati et al. disclose creating an authorization form at the authorization system, displaying the authorization form to the network interface of the user (see col. 10, lines 13-15, 41-67; col. 11, lines 1-8) receiving an authentication phrase from the user, and verifying that the received authentication phrase corresponds to an authentication phrase in the account entry (see col. 11, lines 9-21). Note. The credit authority (CA) generates an email including confirmation information. The confirmation message includes “randomly generated questions on which only the client has knowledge, such as birth date, mother’s maiden name, social security number, etc.”; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select “display mail” using a GUI to view the form using a network interface. “The delivery and communication systems between the client, merchant and TA preferably consists of some type of computer network such as the Internet, private Intranet or **any suitable network**” (see col. 3, lines 56-59). As per receiving an authentication phrase and verifying the phrase, after receiving the authorization form, the user of Talati et al.’s system generates an email message, providing therein a response to the random

Art Unit: 3621

questions generated by the CA. The response to the random question is an authentication phrase. Further, the CA confirms/verifies the answer to the question using the e-mail control system (ECS), which comprises a mailbox database storing e-mail storing "all information necessary to perform validation and authorization procedures at the CA" (see col. 8, lines 45-47; col. 11, lines 27-37). The step of transferring the network interface of the user from the authorization system to the merchant is an inherent step. Talati et al. teach "upon confirmation of the purchase order, the merchandise may be delivered to the client and a credit card transaction can be completed between client 50 and merchant 55", in order to complete the credit card transaction the client must be transferred to the merchant. Talati et al. do not expressly disclose receiving, at an authorization system, merchant information and account information after a user has initiated a transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant, determining whether the account information corresponds to an account entry in an authorization database. Linehan discloses receiving, at an authorization system, merchant information and account information after a user has initiated a transaction from a merchant using a network interface (see col. 4, lines 10-23), verifying that the merchant information corresponds to the merchant, and determining whether the account information corresponds to an account entry in an authorization database (see col. 4, lines 19-30; col. 7, lines 39-49; col. 10, lines 66-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the steps of receiving, at an authorization system, merchant information and accounting information after a user has initiated a transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant and determining whether the account

Art Unit: 3621

information corresponds to an account entry in an authorization database. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

Referring to claims 21 and 25, Talati et al. disclose the signature phrase is used for a plurality of different transactions with different merchants and the same authorizations system is for verifying different transactions for different merchants (see col. 2, lines 51-55).

Referring to claim 23, Talati et al. disclose a method for authorizing transactions (see claim 22 above). Talati et al. do not expressly disclose enabling the network interface of the user to be transferred to the authorization system. Linehan discloses enabling the network interface of the user to be transferred to the authorization system (see col. 15, lines 17-20). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of enabling the network interface of the user to be transferred to the authorization system. One of ordinary skill in the art would have been motivated to do this because it provides means for verification. Note. See rationale regarding transferring network interface in claim 22 above.

Referring to claim 24, Talati et al. disclose forwarding an indication that the transaction is verified to the merchant (see col. 3, lines 49-54).

Referring to claim 26, Talati et al. disclose an authorization form (see col. 10, lines 41-67). Talati et al. do not expressly disclose the authorization form includes information associated with the authorization system. However, it is obvious to modify the authorization form disclose by Talati et al. to include information associated with the authorization system, doing so will not

Art Unit: 3621

depart from the scope of Talati et al.'s system. Also, the information associated with the authorization system is non-functional descriptive information.

Referring to claim 27, Talati et al. disclose the authorization form includes information associated with the user but not provided by the user to the merchant (see col. 10, lines 64-67; col. 11, lines 1-2). Talati et al. disclose an authorization form including "...randomly generated questions on which only the client has knowledge..." this is therefore an authorization form with information associated with the user but not provided by the user to the merchant.

Referring to claim 28, Talati et al. disclose if signature authorization is to occur, preparing an authorization form at the central authorization facility, providing the authorization form to a node, receiving signature authorization form the node through the authorization form, authorizing the first merchant to obtain credit authorization for the first transaction if the signature authorization corresponds to the first user information (see col. 10, lines 13-15, 41-67; col. 11, 1-20), and indicating the authorization to the first merchant (see col. 3, lines 49-54). Note. The CA is the credit authority (See col. 5, line 56). The CA generates an email including confirmation information. The confirmation message includes "randomly generated questions on which only the client has knowledge, such as birth date, mother's maiden name, social security number, etc."; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select "display mail" using a GUI to view the form. As per receiving signature authorization, after receiving the authorization form, the user of Talati et al.'s system generates an email message, providing therein a response to the random questions generated by the CA. The response to the random question is interpreted as signature authorization. Talati et al. do not expressly disclose receiving at a central authorization

Art Unit: 3621

facility, a first merchant information and a first user information from a first merchant for a first transaction or verifying form at least one of the first merchant information and the first user information whether signature authorization is to occur. Linehan discloses receiving at a central authorization facility, a first merchant information and a first user information from a first merchant for a first transaction and verifying form at least one of the first merchant information and the first user information whether signature authorization is to occur (see col. 4, lines 19-30; col. 7, lines 39-49). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the steps of receiving at a central authorization facility, a first merchant information and a first user information from a first merchant for a first transaction and verifying form at least one of the first merchant information and the first user information whether signature authorization is to occur. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

Referring to claims 29 and 30, Talati et al. disclose receiving at the central authorization facility (i.e. "transaction administrator"), merchant information (i.e. "recipient") and user information (i.e. "originator") (see col. 4, lines 50-57, 66-67; col. 5, lines 1-7). Also, Talati et al. disclose performing different transactions for "one or more" merchants and users, i.e. first merchant, second merchant, a second merchant information, first user information and second transaction (see col. 2, lines 51-55). Note. Talati et al. states, "The transaction administrator first validates the identity of recipient..." which implies that the recipient/merchant information has been received by the central authorization facility. As per repeating steps b)-g) for the



Art Unit: 3621

second merchant wherein the same signature authorization is used to authorize the second transaction, see claim 28 above.

Referring to claim 31 and 32, Talati et al. disclose a method for authorizing e-commerce transactions (see claim 28 above). Talati et al. do not expressly disclose providing software to the merchant, wherein the software includes a Buy button. Linehan discloses providing software to the merchant (see col. 20, lines 22-28), wherein the software includes a Buy button (see col. 14, lines 23-27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of providing software to the merchant, wherein the software includes a Buy button. One of ordinary skill in the art would have been motivated to do this because it supports remote purchasing.

Referring to claim 33, Talati et al. disclose the signature authorization is in the form of a signature phrase (see col. 11, lines 11-15).

Referring to claims 34 and 35, Talati et al. disclose the first user information includes a credit card account number (see col. 4, lines 50-56), and the central authorization facility is associated with an issuer of a credit card for the credit card account number (see col. 2, lines 67; col. 3, line 1).

Referring to claim 36, Talati et al. disclose the node indicated by the first account information is an electronic address for a user who initiated the transaction (see col. 10, lines 61-67).

Referring to claim 37, Talati et al. disclose creating an authorization form at the verification system, displaying the authorization form via a network interface of the user (see col.

Art Unit: 3621

10, lines 13-15, 41-67; col. 11, lines 1-8) receiving an authentication phrase from the user, and verifying that the received authentication phrase corresponds to an authentication phrase in the account entry (see col. 11, lines 9-21). Note. The credit authority (CA) generates an email including confirmation information. The confirmation message includes “randomly generated questions on which only the client has knowledge, such as birth date, mother’s maiden name, social security number, etc.”; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select “display mail” using a GUI to view the form using a network interface. “The delivery and communication systems between the client, merchant and TA preferably consists of some type of computer network such as the Internet, private Intranet or **any suitable network**” (see col. 3, lines 56-59). As per receiving an authentication phrase and verifying the phrase, after receiving the authorization form, the user of Talati et al.’s system generates an email message, providing therein a response to the random questions generated by the CA. The response to the random question is an authentication phrase. Further, the CA confirms/verifies the answer to the question using the e-mail control system (ECS), which comprises a mailbox database storing e-mail storing “all information necessary to perform validation and authorization procedures at the CA” (see col. 8, lines 45-47; col. 11, lines 27-37). The step of transferring the network interface of the user from the authorization system to the merchant is an inherent step. Talati et al. teach “upon confirmation of the purchase order, the merchandise may be delivered to the client and a credit card transaction can be completed between client 50 and merchant 55”, in order to complete the credit card transaction the client must be transferred to the merchant. Talati et al. do not expressly disclose receiving, at a verification system, merchant information and account information after a user has initiated a

Art Unit: 3621

transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant, determining whether the account information corresponds to an account entry in an authorization database. Linehan discloses receiving, at an authorization system, merchant information and account information after a user has initiated a transaction from a merchant using a network interface (see col. 4, lines 10-23), verifying that the merchant information corresponds to the merchant, and determining whether the account information corresponds to an account entry in an authorization database (see col. 4, lines 19-30; col. 7, lines 39-49; col. 10, lines 66-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include the steps of receiving, at an authorization system, merchant information and accounting information after a user has initiated a transaction from a merchant using a network interface, verifying that the merchant information corresponds to the merchant and determining whether the account information corresponds to an account entry in an authorization database. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

Referring to claim 38, Talati et al. do not expressly disclose verifying that the merchant information corresponds to the merchant. Linehan discloses verifying that the merchant information corresponds to the merchant (see col. 4, lines 24-28). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Talati et al. to include the step of verifying that the merchant information corresponds to the merchant. One of ordinary skill in the art would have been motivated to do

Art Unit: 3621

this because it ensures that the consumer is dealing with the actual merchant (see col. 4, lines 24-28).

Referring to claim 39, Talati et al. do not expressly disclose sending verification information to the merchant. Linehan discloses sending verification information to the merchant (see col. 4, lines 37-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of sending verification information to the merchant. One of ordinary skill in the art would have been motivated to do this because it provides necessary information for electronic transaction validation.

Referring to claim 40, Talati et al. disclose sending information about the transaction to a credit authorization system (see col. 10, lines 53-57).

Referring to claims 41 and 42, Talati et al. disclose receiving authorization form a credit authorization system; wherein the verification system is a credit authorization system (see col. 10, lines 16-20).

Referring to claim 43, Talati et al. disclose creating an authorization form at the authorization system for the first transaction, displaying the authorization form via an internet browser of the user (see col. 10, lines 13-15, 41-67; col. 11, lines 1-8; col. 12, lines 36-46) receiving a first signature phrase from the customer indicating authorization for the first transaction, and verifying that the received signature phrase corresponds to a stored signature phrase in the credit card account (see col. 11, lines 9-21). Note. The credit authority (CA) generates an email including confirmation information. The confirmation message includes

Art Unit: 3621

“randomly generated questions on which only the client has knowledge, such as birth date, mother’s maiden name, social security number, etc.”; the examiner interprets this confirmation e-mail message as an authorization form. As cited by Talati et al., the user can select “display mail” using a GUI to view the form using a network interface. As per receiving the signature phrase and verifying the phrase, after receiving the authorization form, the user of Talati et al.’s system generates an email message, providing therein a response to the random questions generated by the CA. The response to the random question is the signature phrase. Further, the CA confirms/verifies the answer to the question using the e-mail control system (ECS), which comprises a mailbox database storing e-mail storing “all information necessary to perform validation and authorization procedures at the CA” (see col. 8, lines 45-47; col. 11, lines 27-37). The step of transferring the Internet browser of the customer to a node associated with the e-commerce merchant is an inherent step. Talati et al. teach “upon confirmation of the purchase order, the merchandise may be delivered to the client and a credit card transaction can be completed between client 50 and merchant 55”, in order to complete the credit card transaction the customer must be transferred to the merchant. Talati et al. do not expressly disclose receiving, at a credit card authorization system, e-commerce merchant information and a credit card number of a customer for a first transaction. Linehan discloses receiving, at a credit card authorization system, e-commerce merchant information and a credit card number of a customer for a first transaction (see col. 4, lines 10-23). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Talati et al. to include the step of receiving, at a credit card authorization system, e-commerce merchant information and a credit card number of a customer for a first transaction. One of ordinary skill

Art Unit: 3621

in the art would have been motivated to do this because it prevents unauthorized individuals from using the user's account.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Allowable Subject Matter***

10. Claims 6-9 and 11-15 are allowed.

11. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 20, 2004

  
**JAMES P. TRAMMELL  
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